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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,577	10/10/2006	Atsushi Hamada	2006_0508A	9303

513 7590 06/30/2010
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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1783

NOTIFICATION DATE	DELIVERY MODE
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06/30/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com
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Office Action Summary	Application No. 10/574,577	Applicant(s) HAMADA ET AL.	
	Examiner VICTOR S. CHANG	Art Unit 1783	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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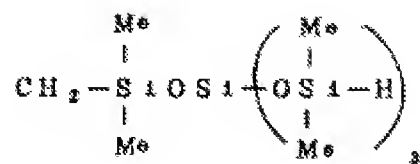
DETAILED ACTION***Introduction***

1. Applicants' amendments and remarks filed on 6/16/2010 have been entered. Claim 1 has been amended. Claims 1-11 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Rejections Based on Prior Art

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02-151677 (English Abstract).

JP '677 relates to an adhesive composition produced by mixing 1) an alkenylated polyether (e.g. allyl glycidyl ether/ethylene oxide copolymer) of an average MW of 10000-5000000, 2) 0.1-10000ppm a platinum compound catalyst, and 3) a Si-H-containing polyorganohydrogensiloxane, e.g.,



See page 605. The adhesive composition is formed by curing the components with hydrosilylation reaction.

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For claims 1-3, JP '677 teaches all the features of the molecular structures of the adhesive composition as claimed. JP '677 is silent about forming an adhesive sheet laminate on a substrate. However, absent any evidence to the contrary, the Official notice "depositing an adhesive composition on a substrate to form an adhesive material is common knowledge" has been taken as admitted prior art, it would have been an obvious modification to one of ordinary skill in the art to do so, motivated by the desire to obtain the convenience of applying the adhesive for end use. Regarding the adhesiveness of the composition, it is deemed to be inherent to the same chemistry. Regarding the use limitation (for skin adhesion), since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). Regarding newly added limitation "the molar ratio of the hydrosilyl group/alkenyl group is 0.3-0.8", since JP '677 teaches generally the same chemistry for the same end use (adhesive) as the claimed invention, workable ratio among the components are deemed to be either anticipated, or obviously provided by practicing the invention of prior art, motivated by the desire to obtain properties required for the same end use as the claimed invention.

For claims 6 and 7, JP '677 teaches that in general alkenylated polyether can be used, and illustrated at page 605 alternative polymeric main chains of polyoxyethylene and polyoxybutylene. Absent any unexpected results, it would have been obvious to one of ordinary skill in the art to select polyoxypropylene as well. Regarding the measurement of molecular weight "in polystyrene conversion", it is interpreted as meaning measuring the molecular weight by a size-exclusion chromatography which has been calibrated by polystyrene standards. While JP '677 is silent about the standards used for molecular weight measurement, JP '677 does teach

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a molecular weight range which overlaps and therefore reads on the claimed molecular weight range in claim 7.

For claim 8, since JP '677 teaches generally the same chemistry of making the adhesive for the same end use, workable degree of curing by hydrosilylation reaction, and therefore the resultant toluene-insoluble cured component in the composition is deemed to be obvious routine optimization to one of ordinary skill in the art, motivated by the desire to obtain the required adhesiveness by curing for the same end use as the claimed invention.

For claim 9, for the same reasons set forth above, the moisture permeability is deemed to be inherent to the same chemistry as the claimed invention.

For claims 4, 5, 10 and 11, JP '677 is silent about the use of platinum-vinyl siloxane complex as the catalyst for the hydrosilylation reaction. However, absent any evidence to the contrary, the Official notice "platinum-vinyl siloxane complex is common and well known for hydrosilylation reaction" has been taken as admitted prior art, in the absence of any unexpected results, the selection of a known catalyst for intended reaction is deemed to be obvious to one of ordinary skill in the art. Further, the genus platinum-vinyl siloxane complex clearly encompasses the various species, including platinum-1,3-divinyl-1,1,3,3-tetramethyldisiloxane.

Response to Arguments

5. Applicants admit at Remarks page 6:

"It is certain that a cured product of the adhesive composition constituting an adhesive layer of a pressure-sensitive adhesive sheet according to the claimed invention is closely related chemically to a cured product of a hydrosilylation reaction curable composition disclosed in JP 02-151677."

But argue at page 7:

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“However, it is intended that a hydrosilylation reaction curable composition disclosed within JP 02-151677 is particularly used as a dental impression material (see page 604, lower left column, lines 9 - 10), and, in general, a dental impression material is not used in the form of a pressure-sensitive adhesive sheet. Accordingly, laminating a hydrosilylation reaction curable composition disclosed within JP 02-151677 on a substrate to form a pressure-sensitive adhesive sheet would not be obvious to one of ordinary skill in the art. Further, JP 02-151677 makes no mention of the problem to be solved by the claimed invention, i.e., provision of a pressure-sensitive adhesive sheet for skin adhesion that can be easily adhered to skin, that does not irritate skin easily, and that does not damage stratum corneum easily.”

However, absent any evidence to the contrary, the Official notice “depositing an adhesive composition on a substrate to form an adhesive material is common knowledge” has been taken as admitted prior art, it would have been an obvious modification to one of ordinary skill in the art to do so, motivated by the desire to obtain the convenience of applying the adhesive for end use. Further, as pointed out by applicants that the adhesive of JP ‘677 is known for use in contact with denture, which is part of human body, it would have been reasonably obvious to one of ordinary skill in the art to form various adhesive sheets, such as bandage, for attaching to other human body parts, such as skin, without adverse effect. Applicants' argument directed to features taught by JP ‘677 not relied upon is misplaced.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 6:00 am - 4:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1783